

## **REMARKS/ARGUMENTS**

### **A. Claim Objections**

Claims 1 and 15-17 are objected to because of informalities. Claims 1 and 15-17 have been amended to address these objections. Accordingly, Applicants respectfully request that the objection to claims 1 and 15-17 be withdrawn.

### **B. Claims 1 and 15-17 Rejected Under 35 U.S.C. § 112, Second Paragraph**

Claims 1 and 15-17 are rejected under 35 U.S.C. § 112, second paragraph. Applicants have amended the claims to address these rejections. Accordingly, Applicants respectfully request that the rejection of claims 1 and 15-17 be withdrawn.

### **C. Claims 1-4, 8-10, 13, 15-21, 25, 28 and 30-32 Rejected Under 35 U.S.C. § 102(b)**

Claims 1-4, 8-10, 13, 15-21, 25, 28 and 30-32 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0143643 to Catan (hereinafter, "Catan"). Applicants respectfully request reconsideration in view of the above claim amendments and the following remarks.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, "the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Claim 1

Known object identifier readers (e.g., bar code readers, RFID readers, magnetic stripe readers, etc.) may be used in a “live” mode where data is sent immediately to a host computer. Alternatively, they may be used in a “batch” mode where data is stored and later uploaded to a host computer.

In contrast to known object identifier readers, the subject matter of claim 1 is directed to an “object identifier reader” that “read[s] an object identifier to obtain data” and then “automatically determin[es] whether to send the data to the host computing device or to store the data in the storage medium.” In addition, the claimed “object identifier reader” “automatically attempt[s] to send stored data in the storage medium to the host computing device in response to determining that the object identifier reader is connected to the host computing device.”

An advantage of the claimed “object identifier reader” is described in Applicants’ specification as follows:

An object ID reader 104 that is configured in this manner may be useful in a wireless environment where the user may move in and out of connection range of the host 106. When the object ID reader 104 is connected to the host 106, data 116 may be sent to the host 106. When the object ID reader 104 is out of range, data 116 may be stored in the storage medium 114 and then automatically uploaded to the host 106 when a connection can be established again.

(Applicants’ specification, paragraph [0044].)

Applicants respectfully submit that Catan does not describe “automatically determining whether to send the data to the host computing device or to store the data in the storage medium,” as recited in claim 1. This subject matter is being added<sup>1</sup> to claim 1 by this paper. Therefore, the Examiner has not yet had an opportunity to consider whether Catan describes this claimed subject matter. Applicants note that Catan describes transferring data from a portable reader 100 to a computer 190. (*See* Catan, par. [0061].) However, Catan does not describe “automatically

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<sup>1</sup> This amendment is supported by at least paragraph [0044] of Applicants’ specification.

determining whether to send the data to the [computer 190] or to store the data in the storage medium” of the portable reader 100, as required by claim 1.

Applicants also respectfully submit that Catan does not describe “automatically attempting to send stored data in the storage medium to the host computing device in response to determining that the object identifier reader is connected to the host computing device,” as recited in claim 1. This subject matter is being added<sup>2</sup> to claim 1 by this paper. Therefore, the Examiner has not yet had an opportunity to consider whether Catan describes this claimed subject matter. As indicated above, Catan describes transferring data from a portable reader 100 to a computer 190. However, Catan does not describe that this data transfer occurs “automatically ... in response to determining that the [portable reader 100] is connected to the [computer 190],” as required by claim 1.

For at least the foregoing reasons, Applicants respectfully submit that claim 1 is allowable.

#### Claims 2-4, 8-10 and 13

Claims 2-4, 8-10 and 13 depend from claim 1. Accordingly, Applicants respectfully submit that claims 2-4, 8-10 and 13 are allowable for at least the same reasons as presented above in relation to claim 1.

#### Claim 15

Applicants respectfully submit that Catan does not describe “automatically determining whether the object identifier reader is connected to the host computing device and automatically attempting to connect to the host computing device if the object identifier reader is not connected to the host computing device,” as recited in claim 15. This subject matter is being added<sup>3</sup> to claim 15 by this paper. Therefore, the Examiner has not yet had an opportunity to consider whether Catan describes this claimed subject matter. As indicated above, Catan describes transferring data from a portable reader 100 to a computer 190. However, Catan does not describe “automatically

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<sup>2</sup> This amendment is supported by at least paragraphs [0044] and [0051]-[0052] of Applicants' specification.

<sup>3</sup> This amendment is supported by at least paragraphs [0044] and [0047]-[0048] of Applicants' specification.

determining whether the [portable reader 100] is connected to the [computer 190] and automatically attempting to connect to the [computer 190] if the [portable reader 100] is not connected to the [computer 90],” as recited in claim 15.

Applicants also respectfully submit that Catan does not describe “automatically attempting to send stored data in the storage medium to the host computing device in response to determining that the object identifier reader is connected to the host computing device,” as recited in claim 15. This claimed subject matter was discussed above in relation to claim 1.

For at least the foregoing reasons, Applicants respectfully submit that claim 15 is allowable.

#### Claim 16

Applicants respectfully submit that Catan does not describe “automatically determining whether the storage medium is empty, and if the storage medium is empty, automatically making at least one attempt to send the data to the host computing device,” as recited in claim 16. This subject matter is being added<sup>4</sup> to claim 16 by this paper. Therefore, the Examiner has not yet had an opportunity to consider whether Catan describes this claimed subject matter. However, Applicants cannot find any part of Catan that describes a conditional relationship between “send[ing] the data to the host computing device” and “determining whether the storage medium is empty,” as required by claim 16.

Applicants also respectfully submit that Catan does not describe “storing the data in the storage medium if the at least one attempt [to send the data to the host computing device] fails or if the storage medium is not empty,” as recited in claim 16. The Examiner asserts that this claimed subject matter is described by the abstract and paragraph [0015] of Catan. (Office Action, page 4.) Applicants respectfully disagree.

The abstract of Catan describes a terminal saving data in memory if it cannot connect with a network server. In contrast, claim 16 requires that an “object identifier reader ... stor[e] the data in the storage medium if the at least one attempt fails or if the storage medium is not empty.” The

terminal in Catan is not an “object identifier reader.” (See Figure 1 of Catan, which shows the terminal 120 as a personal computer, probably analogous to the “host computing device” in claim 16.)

As best understood, paragraph [0015] of Catan does not have anything to do with “storing the data in the storage medium if the at least one attempt fails or if the storage medium is not empty,” as recited in claim 16. Paragraph [0015] of Catan merely describes various aspects of a “smart kitchen.” If the Examiner maintains the rejection, Applicants respectfully request that the Examiner specifically describe which part of paragraph [0015] of Catan allegedly describes “storing the data in the storage medium if the at least one attempt fails or if the storage medium is not empty.”

Applicants also respectfully submit that Catan does not describe “automatically determining whether the object identifier reader is connected to the host computing device and automatically attempting to connect to the host computing device if the object identifier reader is not connected to the host computing device,” as recited in claim 16. This claimed subject matter was discussed above in relation to claim 15.

Applicants also respectfully submit that Catan does not describe “automatically attempting to send stored data in the storage medium to the host computing device in response to determining that the object identifier reader is connected to the host computing device,” as recited in claim 16. This claimed subject matter was also discussed above in relation to claim 15.

For at least the foregoing reasons, Applicants respectfully submit that claim 16 is allowable.

#### Claim 17

Applicants respectfully submit that Catan does not describe “automatically determining whether the object identifier reader is connected to the host computing device and automatically attempting to connect to the host computing device if the object identifier reader is not connected to the host computing device,” as recited in claim 17. This claimed subject matter was discussed above in relation to claim 15.

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<sup>4</sup> This amendment is supported by at least paragraphs [0044] and [0051]-[0052] of Applicants’ specification.

Applicants also respectfully submit that Catan does not describe “automatically attempting to send stored data in the storage medium to the host computing device in response to determining that the object identifier reader is connected to the host computing device,” as recited in claim 17. This claimed subject matter was also discussed above in relation to claim 15.

Applicants also respectfully submit that Catan does not describe “storing the data in the storage medium if the at least one attempt [to send the data to the host computing device] fails,” as recited in claim 17. This claimed subject matter was discussed above in relation to claim 16.

For at least the foregoing reasons, Applicants respectfully submit that claim 17 is allowable.

#### Claims 18-21, 25 and 28

The subject matter of claim 18 is similar to the subject matter of claim 1. Claims 19-21, 25 and 28 depend from claim 18. Accordingly, Applicants respectfully submit that claims 18-21, 25 and 28 are allowable for at least the same reasons as presented above in relation to claim 1.

#### Claim 30

The subject matter of claim 30 is similar to the subject matter of claim 15. Accordingly, Applicants respectfully submit that claim 30 is allowable for at least the same reasons as presented above in relation to claim 15.

#### Claim 31

The subject matter of claim 31 is similar to the subject matter of claim 16. Accordingly, Applicants respectfully submit that claim 31 is allowable for at least the same reasons as presented above in relation to claim 16.

Claim 32

The subject matter of claim 32 is similar to the subject matter of claim 17. Accordingly, Applicants respectfully submit that claim 32 is allowable for at least the same reasons as presented above in relation to claim 17.

**D. Claims 5-7 and 22-24 Rejected Under 35 U.S.C. § 103(a)**

Claims 5-7 and 22-24 stand rejected under 35 U.S.C. § 103(a) based on *Catan* in view of U.S. Patent Application Publication No. 2005/0103854 to Zhu et al. (hereinafter, “Zhu”). Applicants respectfully request reconsideration in view of the above claim amendments and the following remarks.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). As the Board of Patent Appeals and Interferences has recently confirmed, “obviousness requires a suggestion of all limitations in a claim.” In re Wada and Murphy, Appeal 2007-3733 (citing CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003)).

Claims 5-7 depend from claim 1. Claims 22-24 depend from claim 18, which includes subject matter that is similar to the subject matter of claim 1.

As indicated above, *Catan* does not describe the following subject matter in claim 1: “automatically determining whether to send the data to the host computing device or to store the data in the storage medium,” and “automatically attempting to send stored data in the storage medium to the host computing device in response to determining that the object identifier reader is connected to the host computing device.” Because this subject matter is being added to claim 1 by this paper, the Examiner has not yet had an opportunity to consider whether Zhu describes this claimed subject matter. However, Applicants cannot find this claimed subject matter anywhere in Zhu.

Accordingly, Applicants respectfully submit that even if Catan and Zhu were combined, the resulting combination would not include “automatically determining whether to send the data to the host computing device or to store the data in the storage medium,” and “automatically attempting to send stored data in the storage medium to the host computing device in response to determining that the object identifier reader is connected to the host computing device,” as recited in claim 1. Therefore, Applicants respectfully submit that claims 5-7 (which depend from claim 1) and claims 22-24 (which depend from claim 18, which includes subject matter that is similar to the subject matter of claim 1) are allowable.

**E. Claims 11-12 and 26-27 Rejected Under 35 U.S.C. § 103(a)**

Claims 11-12 and 26-27 stand rejected under 35 U.S.C. § 103(a) based on Catan in view of U.S. Patent No. 6,289,355 to Haderle et al. (hereinafter, “Haderle”). Applicants respectfully request reconsideration in view of the above claim amendments and the following remarks.

The standard for establishing a rejection under 35 U.S.C. § 103(a) is provided above.

Claims 11-12 depend from claim 1. Claims 26-27 depend from claim 18, which includes subject matter that is similar to the subject matter of claim 1.

As indicated above, Catan does not describe the following subject matter in claim 1: “automatically determining whether to send the data to the host computing device or to store the data in the storage medium,” and “automatically attempting to send stored data in the storage medium to the host computing device in response to determining that the object identifier reader is connected to the host computing device.” Because this subject matter is being added to claim 1 by this paper, the Examiner has not yet had an opportunity to consider whether Haderle describes this claimed subject matter. However, Applicants cannot find this claimed subject matter anywhere in Haderle.

Accordingly, Applicants respectfully submit that even if Catan and Haderle were combined, the resulting combination would not include “automatically determining whether to send the data to the host computing device or to store the data in the storage medium,” and “automatically attempting to send stored data in the storage medium to the host computing device in response to determining



that the object identifier reader is connected to the host computing device,” as recited in claim 1. Therefore, Applicants respectfully submit that claims 11-12 (which depend from claim 1) and claims 26-27 (which depend from claim 18, which includes subject matter that is similar to the subject matter of claim 1) are allowable.

**F. Claims 14 and 29 Rejected Under 35 U.S.C. § 103(a)**

Claims 14 and 29 stand rejected under 35 U.S.C. § 103(a) based on Catan in view of U.S. Patent Application Publication No. 2003/0222150 to Sato et al. (hereinafter, “Sato”). Applicants respectfully request reconsideration in view of the above claim amendments and the following remarks.

The standard for establishing a rejection under 35 U.S.C. § 103(a) is provided above.

Claim 14 depends from claim 1. Claim 29 depends from claim 18, which includes subject matter that is similar to the subject matter of claim 1.

As indicated above, Catan does not describe the following subject matter in claim 1: “automatically determining whether to send the data to the host computing device or to store the data in the storage medium,” and “automatically attempting to send stored data in the storage medium to the host computing device in response to determining that the object identifier reader is connected to the host computing device.” Because this subject matter is being added to claim 1 by this paper, the Examiner has not yet had an opportunity to consider whether Sato describes this claimed subject matter. However, Applicants cannot find this claimed subject matter anywhere in Sato.

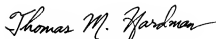
Accordingly, Applicants respectfully submit that even if Catan and Sato were combined, the resulting combination would not include “automatically determining whether to send the data to the host computing device or to store the data in the storage medium,” and “automatically attempting to send stored data in the storage medium to the host computing device in response to determining that the object identifier reader is connected to the host computing device,” as recited in claim 1. Therefore, Applicants respectfully submit that claim 14 (which depends from claim 1) and claim 29

(which depends from claim 18, which includes subject matter that is similar to the subject matter of claim 1) are allowable.

**G. Conclusion**

Applicants respectfully assert that all pending claims are allowable over the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,



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